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REMARKS/ARGUMENTS

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

Claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatfield et al. (US 5,753,473) taken with Lepper et al. (US 4,608,202). This rejection is respectfully traversed for the following reasons.

Briefly stated, the present invention is directed to a process for making deacidified fats and/or oils involving reacting a triglyceride with a lower alcohol, in the presence of a lipase catalyst to form a pre-esterification product (an ester), and then further reacting the pre-esterification product with additional alcohol to form a product having an acid value of from about 0.1 to 0.5.

It is extremely well settled that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure [underline emphases added]. See, *Manual of Patent Examining Procedure*, Rev. 3, July 1997, § 2142, pages 2100-108. Applicant respectfully submits that neither Gatfield nor Lepper, alone or in combination, teach or suggest all of the claim limitations of the present invention and, as a result, fail to render the claimed invention *prima facie* obvious.

With respect to the Gatfield reference, it is directed to the preparation of a DDAE

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ester by **transesterification** of an ester of DDA with a lipase, in the presence of ethanol. It is extremely well known by those skilled in the art of organic chemistry that **transesterification** is different from **esterification**. More particularly, esterification is the process by which an ester is formed by reacting an **alcohol** with an **acid**. Transesterification, on the other hand, is the reaction between an **ester** and **another compound** with exchange of alkoxy or acyl groups to form a different ester. Thus, whereas esterification involves forming an ester, transesterification involves changing one ester to another ester. The difference, therefore, between the teaching of the Gatfield reference and that of the claimed invention is obvious, i.e., **transesterification** versus **esterification**.

As for the Lepper reference, it is directed to a process for making fatty acid esters by catalytic transesterification by first forming a preliminary ester by reacting a fatty acid with an aliphatic alcohol, in the presence of an **acidic** catalyst, followed by the subsequent transesterification of the preliminary ester to form the final ester product. The Lepper reference, however, clearly differs from the claimed invention in its use of an acidic catalyst rather than the claimed enzymatic lipase catalyst. Nowhere within the four corners of the Lepper reference is it either taught or suggested to employ the claimed lipase catalyst rather than Lepper's acidic catalyst. Rather, the only catalyst advocated by the Lepper reference is an acidic catalyst. Moreover, Lepper is apparently so satisfied with the performance of acidic catalysts that it is willing to incorporate the use of an additional ingredient, i.e., an entraining liquid, which clearly adds to the cost of performing the process, just for the privilege of being able to use an acidic catalyst, as is evidenced by the statement, "*The entraining agent serves in particular as a liquid carrier for the acidic catalyst in the first stage (preliminary esterification).*" See, col. 5, line 6-8 of the Lepper reference.

In view of the above, it is clear that neither Gatfield nor Lepper, alone or in combination, teach or suggest the present invention. Neither reference teaches a process

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for making deacidified fats and/or oils involving reacting a triglyceride with a lower alcohol, in the presence of a lipase catalyst to form a pre-esterification product (an ester), and then further reacting the pre-esterification product with additional alcohol to form a product having an acid value of from about 0.1 to 0.5. Gatfield relates to **transesterifying** esters, which is clearly different from the claimed **esterification** process and Lepper relates to the formation of esters using **acidic** catalysts which are clearly different from the claimed **enzymatic** (lipase) catalysts.

The Examiner's attempt in trying to substitute Lepper's use of an acidic catalyst with Gatfield's use of a lipase catalyst, which is neither taught, suggested nor motivated in **either reference**, is impermissible for establishing prima facie obviousness. It is well settled that an Examiner cannot establish obviousness through references describing various aspects of an Applicant's invention unless the Examiner also provides evidence of motivating force to compel a person skilled in the art to do what Applicant has done. See, Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Applicant respectfully submits that the Examiner has failed to provide the requisite evidence of motivating force.

Finally, with respect to the Examiner's contention that while the references admittedly fail to teach or suggest the claimed parameters relating to substrate, alcohol and lipase concentration, these amount to nothing more than mere optimization, Applicant respectfully disagrees. It appears as though the Examiner, instead of providing evidence in the form of some teaching or suggestion as to why these parameters would be obvious to those of ordinary skill in the art, has instead based her conclusion of obviousness on an impermissible "obvious-to-try" rationale. In response thereto, Applicant would like to note that it is well settled that where the prior art gives either no indication as to which parameters are critical or no direction as to which of many possible choices is likely to be successful, prima facie obviousness may not be based on an improper "obvious-to-try" rationale. See, In re O'Farrell, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). Clearly, neither


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reference provides any indication as to which parameters are critical and/or which possible choices may be successful. As a result, the claimed parameters are not rendered prima facie obvious by these two references.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

Respectfully submitted,

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